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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,619	06/18/2001	Robert Martin Wynalda JR.	1949-A-CIP	5116

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EXAMINER

SIMONE, CATHERINE A

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/883,619

Applicant(s)

WYNALDA ET AL.

Examiner

Catherine Simone

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation “adapted to” in claims 1, 2, 7, 16, 19 and 20 is deemed vague and indefinite. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1-4, 6, 10, 16 and 17** are rejected under 35 U.S.C. 102(b) as being anticipated by Roze (4,823,950).

Roze discloses a storage container for holding items of recorded media; the storage container comprising a cover having a front cover member (Fig. 2, #52), a rear cover member (Fig. 2, #51), and a spine (Fig. 2, #60) disposed between the front and rear cover members; a page (Fig. 2, #30) adapted to hold at least one item of recorded media; the page (Fig. 2, #30)

having at least one edge; the edge of the page being connected to the spine (Fig. 2, #60) to connect the page to the cover; and the front (Fig. 2, #52) and rear (Fig. 2, #51) cover members being moveable between open and closed positions (see col. 1, lines 52-56). Regarding **claim 2**, note each page is adapted to hold two items of recorded media (Fig. 2, #30). Regarding **claim 3**, note each page includes two page halves connected together (Fig. 2, #30). Regarding **claim 4**, note each page is substantially rigid (see col. 2, line 22). Regarding **claim 6**, note each page is connected to the cover with an adhesive (see col. 4, lines 1-7). Regarding **claim 10**, note the page halves are connected together with adhesive (see col. 3, lines 55-61 and col. 4, lines 1-7). Regarding **claim 16**, note a second page (Fig. 2, #40) adapted to hold at least one item of recorded media; the second page (Fig. 2, #40) having at least one edge; the edge of the second page connected to the cover (Fig. 2, #52). Regarding **claim 17**, note the cover defines a hinge between the front cover member and the spine and a hinge between the rear cover member and the spine (see col. 4, lines 33-38).

It has been held that the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over Roze (4,823,950) in view of House (5,791,468).

Roze discloses a storage container for holding items of recorded media; the storage container comprising a cover having a front cover member (Fig. 2, #40), a rear cover member (Fig. 2, #20), and a spine (Fig. 2, #60) disposed between the front and rear cover members; a page (Fig. 2, #30) adapted to hold at least one item of recorded media; the page (Fig. 2, #30) having at least one edge; the edge of the page being connected to the spine (Fig. 2, #60) to connect the page to the cover; and the front (Fig. 2, #40) and rear (Fig. 2, #20) cover members being moveable between open and closed positions. However, Roze fails to disclose the cover being made of paperboard. House teaches a cover being made of paperboard (see col. 6, lines 7-9) in the analogous art for the purpose of producing a storage container for holding items of recorded media.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the cover in Roze to be made from paperboard as suggested in House in order to produce a storage container for holding items of recorded media.

7. **Claim 7** is rejected under 35 U.S.C. 103(a) as being unpatentable over Roze (4,823,950) in view of House (5,791,468).

Roze discloses a storage container for holding items of recorded media; the storage container comprising a cover having a front cover member (Fig. 2, #40), a rear cover member (Fig. 2, #20), and a spine (Fig. 2, #60) disposed between the front and rear cover members; a page (Fig. 2, #30) adapted to hold at least one item of recorded media; the page (Fig. 2, #30)

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having at least one edge; the edge of the page being connected to the spine (Fig. 2, #60) to connect the page to the cover; and the front (Fig. 2, #40) and rear (Fig. 2, #20) cover members being moveable between open and closed positions (see col. 1, lines 52-56); each page (Fig. 2, #30) being adapted to hold two items of recorded media; each page (Fig. 2, #30) including two page halves connected together; each page being substantially rigid (see col. 4, lines 27-38). However, Roze fails to disclose the cover being fabricated from paperboard. House teaches a cover being made of paperboard (see col. 6, lines 7-9) in the analogous art for the purpose of producing a storage container for holding items of recorded media.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the cover in Roze to be fabricated from paperboard as suggested in House in order to produce a storage container for holding items of recorded media.

Furthermore, Roze fails to disclose the edge of the page connected to the cover being V-shaped in cross section. Normally, it is to be expected that a change in shape of the cross section would be an unpatentable modification. Under some circumstances, however, changes such as shape may impart patentability to a product if the particular shape claimed produces a new and unexpected result which is different in kind and not merely in degree from the results of the prior art. *In re Dailey et al*, 149 USPQ 47 CCPA 1966.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to change the shape of the cross section of the edge of the page in Roze to a V-shape. One skilled in the art would have been motivated to do so in order to form a storage container for holding items of recorded media, since it has been held that the change in

form or shape of the cross section would be an unpatentable modification absence of showing unexpected results.

8. **Claim 11** is rejected under 35 U.S.C. 103(a) as being unpatentable over Roze (4,823,950) in view of Udwin et al. (6,106,015).

Roze discloses a storage container for holding items of recorded media; the storage container comprising a cover having a front cover member (Fig. 2, #40), a rear cover member (Fig. 2, #20), and a spine (Fig. 2, #60) disposed between the front and rear cover members; a page (Fig. 2, #30) adapted to hold at least one item of recorded media; the page (Fig. 2, #30) having at least one edge; the edge of the page being connected to the spine (Fig. 2, #60) to connect the page to the cover; and the front (Fig. 2, #40) and rear (Fig. 2, #20) cover members being moveable between open and closed positions. However, Roze fails to disclose the page halves being connected together with a weld. Udwin et al. teaches in the analogous art welding (see col. 6, lines 10-12) for the purpose of providing secure attachment of each page halve in producing a storage container for recorded media.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided a weld in Roze as suggested by Udwin et al. in order to provide a secure attachment of each page halve in producing a storage container for recorded media.

9. **Claims 8, 9 and 12-15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Roze (4,823,950) in view of Youngs (4,850,731).

Roze discloses a storage container for holding items of recorded media; the storage container comprising a cover having a front cover member (Fig. 2, #52), a rear cover member

(Fig. 2, #51), and a spine (Fig. 2, #60) disposed between the front and rear cover members; a page (Fig. 2, #30) adapted to hold at least one item of recorded media; the page (Fig. 2, #30) having at least one edge; the edge of the page being connected to the spine (Fig. 2, #60) to connect the page to the cover; and the front (Fig. 2, #52) and rear (Fig. 2, #51) cover members being moveable between open and closed positions. However, Roze fails to disclose the page halves being connected with locking fingers and a literature card disposed between the page halves. Youngs teaches page halves being connected with locking fingers (Fig. 4, #70) and a literature card (Fig. 4, #12) disposed between the page halves in the analogous art for the purpose of connecting the page halves together in a storage container for holding recorded media.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided locking fingers to connect the page halves and a literature card disposed between the page halves in Roze as suggested by Youngs in order to produce a storage container for holding recorded media.

10. **Claim 18** is rejected under 35 U.S.C. 103(a) as being unpatentable over Roze (4,823,950) in view of Gelardi et al. (4,793,480).

Roze discloses a storage container for holding items of recorded media; the storage container comprising a cover having a front cover member (Fig. 2, #52), a rear cover member (Fig. 2, #51), and a spine (Fig. 2, #60) disposed between the front and rear cover members; a page (Fig. 2, #30) adapted to hold at least one item of recorded media; the page (Fig. 2, #30) having at least one edge; the edge of the page being connected to the spine (Fig. 2, #60) to connect the page to the cover; and the front (Fig. 2, #52) and rear (Fig. 2, #51) cover members being moveable between open and closed positions; and the cover defines a hinge between the

front cover member and the spine and a hinge between the rear cover member and the spine (see col. 4, lines 33-38). However, Roze fails to disclose the hinge as being a living hinge. Gelardi et al. teaches a living hinge (see col. 7, lines 62-64) in the analogous art for the purpose of producing a storage container for holding items of recorded media.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the hinge in Roze to be a living hinge as suggested by Gelardi et al. in order to produce a storage container for holding items of recorded media.

11. **Claim 19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Roze (4,823,950) in view of House (5,791,468) and in further view of Gelardi et al. (4,793,480).

Roze discloses a storage container for holding items of recorded media; the storage container comprising a cover (Fig. 2, #50) having a front cover member (Fig. 2, #52), a rear cover member (Fig. 2, #51), and a spine (Fig. 2, #60) disposed between the front and rear cover members; the cover members defining a hinge between the front cover member and the spine (see col. 4, lines 33-37); a page adapted to hold two items of recorded media on opposite sides of the page (see col. 3, lines 10-17); the page having at least one edge; the edge of the page being connected to the spine with an adhesive to connect the page to the cover (see col. 3, lines 55-61 and col. 4, lines 1-7); each page being substantially rigid (see col. 4, line 27); and the front and rear cover members being moveable between open and closed positions (see col. 1, lines 52-56). However, Roze fails to disclose the cover being made of paperboard and the hinge being a living hinge. House teaches a cover being made of paperboard (see col. 6, lines 7-9) in the analogous art for the purpose of producing a storage container for holding items of recorded media. Gelardi

et al. teaches a living hinge (see col. 7, lines 62-64) in the analogous art for the purpose of producing a storage container for holding items of recorded media.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the cover in Roze to be made from paperboard as suggested in House and the hinge in Roze to be a living hinge as suggested by Gelardi et al. in order to produce a storage container for holding items of recorded media.

12. **Claim 20** is rejected under 35 U.S.C. 103(a) as being unpatentable over Roze (4,823,950) in view of Youngs (4,850,731).

Roze discloses a storage container for holding items of recorded media; the storage container comprising a cover having a front cover member (Fig. 2, #40), a rear cover member (Fig. 2, #20), and a spine (Fig. 2, #60) disposed between the front and rear cover members; a page (Fig. 2, #30) adapted to hold two items of recorded media on opposite sides of the page; the page (Fig. 2, #30) having at least one edge; the edge of the page being connected to the spine (Fig. 2, #60) with an adhesive to connect the page to the cover (see col. 3, lines 55-61 and col. 4, lines 1-7); each page (Fig. 2, #30) being substantially rigid (see col. 4, lines 33-40) and including two halves; and the front (Fig. 2, #40) and rear (Fig. 2, #20) cover members being moveable between open and closed positions (see col. 1, lines 52-56). However, Roze fails to disclose a literature card being disposed between the page halves. Youngs teaches in the analogous art a literature card (Fig. 4, #12) being disposed between page halves for the purpose of producing a storage container for holding items of recorded media.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided a literature card being disposed between the

page halves in Roze as suggested by Youngs in order to produce a storage container for holding items of recorded media.

Response to Arguments

13. Applicant's arguments with respect to claims 1-18 and 20 have been considered but are moot in view of the new ground(s) of rejection.

14. Applicant's arguments filed December 23, 2002 have been fully considered but they are not persuasive. Regarding claim 19, Applicant states "The page of the Roze reference is disclosed as being directly connected to other pages that are, in turn, connected to the front and rear cover members. The spine of the cover member is disclosed to the left of reference numeral 60 in Fig. 4. Fig. 4 clearly shows that nothing is connected to the spine. Fig. 4 shows that no pages are connected to the spine." However, it is to be pointed out in Fig. 2 of the Roze reference that reference numeral 60 clearly shows a spine and the pages (#40, #30, #20) are clearly connected to that spine. In addition, it is be pointed out in the Roze reference that "the rectangular frame and the planar members are secured together to form a book-like assembly wherein the planar members and the rectangular frame are rotatably secured together so that they function like leaves in a book" (see col. 1, lines 52-56). This clearly points about that the pages are connected to the spine in the Roze reference.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (703) 605-4297. The examiner can normally be reached on 9:30-6:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (703) 308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Catherine Simone
Examiner
Art Unit 1772

February 25, 2003



HAROLD PYON
SUPERVISORY PATENT EXAMINER
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